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APPLICATION NO. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOX:KET NO.	CONFIRMATION NO.	
09/964,650	09/28/2001	Andreas Wachtler	MERCK-1497 (C3)	2034	
23599	7590 07/14/2004		EXAM	4INER	
· · ·	WHITE, ZELANO & F	WU, SHEA	WU, SHEAN CHIU		
2200 CLARENDON BLVD. SUITE 1400			ART UNIT	PAPER NUMBER	
ARLINGTON, VA 22201			1756	1756 / 4	
		DATE MAILED: 07/14/2004			

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application	No	Applicant(s)				
Office Action Summary			Ĩ					
		09/964,650		WACHTLER ET AL				
		Examiner		Art Unit				
		Shean C W		1756				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply								
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).								
Status								
1) 又	Responsive to communication(s) filed on 17	June 2004.						
′=	•	·						
3)□	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.							
Dispositi	ion of Claims							
5)⊠ 6)⊠ 7)□ 8)□ <b>Applicat</b> i	Claim(s) 1 and 7-56 is/are pending in the appear of the above claim(s) is/are withdred claim(s) 1,7-17 and 54 is/are allowed.  Claim(s) 18-53,55 and 56 is/are rejected.  Claim(s) is/are objected to.  Claim(s) are subject to restriction and it is a specification is objected to by the Examination of the drawing(s) filed on is/are: a) and are subjected to by the Examination of the drawing(s) filed on is/are: a)	rawn from cons	uirement.	-xaminer				
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).								
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.								
Priority u	ınder 35 U.S.C. § 119							
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No. 08/046,286.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>								
2) Notice 3) Information	t(s)  e of References Cited (PTO-892)  e of Draftsperson's Patent Drawing Review (PTO-948)  mation Disclosure Statement(s) (PTO-1449 or PTO/SB/0  r No(s)/Mail Date		) Interview Summary ( Paper No(s)/Mail Da ) Notice of Informal Pa ) Other:	te	152)			



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#### **DETAILED ACTION**

### **Double Patenting**

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 18-53 and 55-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 6,677,002.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matters overlap each other (X=F, Cl and Y=H or F).

## Allowable Subject Matter

3. Claims 1, 7-17 and 54 are allowed.

### Response to Arguments

4. Applicant's arguments with respect to claims 18-53 and 55-56 have been considered but are most in view of the new ground(s) of rejection.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shean C Wu whose telephone number is 571-272-1393. The examiner can normally be reached on 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shean C Wu Primary Examiner

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